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In re Application of FOLINO et al.	:
Application No.: 09/913,233	: DECISION ON PETITION
PCT No.: PCT/CA00/00128	:
Int. Filing: 10 February 2000	: FOR RECONSIDERATION
Priority Date: 10 February 1999	:
Attorney Docket No.: 19345-087835	: UNDER 37 CFR 1.47(a)
For: GASKET INSTALLATION APPARATUS	:
	:

This is a decision on applicant's petition for reconsideration under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 28 August 2002. Petitioner's request for a three month extension of time is granted.

### **BACKGROUND**

On 27 September 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 27 November 2001, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Salvatore J. Folino, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Peter Vert and Cecil Beaman on behalf of Salvatore J. Folino and a statement of facts under 37 CFR 1.47(a).

On 28 March 2002, a decision was mailed to applicants dismissing the petition on the grounds that petitioner had not presented sufficient evidence to conclude that applicant/inventor Salvatore J. Folino refused to sign the application.

On 28 August 2002, applicant filed the instant request for reconsideration of the petition accompanied by the declarations of Jeffrey T. Imai, Chief Patent Counsel for Magna International (parent company of Tesma International, Inc.) and Jo-Ann Percy, assistant to Mr. Imai.

### **DISCUSSION**

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicants have previously satisfied Items (1), (3) and (4) above.

With respect to item (2), applicant must demonstrate that Salvatore J. Folino has refused to sign the declaration by conduct constituting a refusal to sign the declaration for the above referenced application. Petitioner previously provided a copy of a letter mailed to Mr. Folino on September 25, 2001 at his last known residence, to which Mr. Folino did not respond. The letter indicated that the "U.S. declaration and Power of Attorney document together with a copy of the application as filed" were sent to Mr. Folino's home address by Jeffrey T. Imai.

Petitioner now submitted declarations of Mr. Imai and Ms. Percy having first-hand knowledge of Mr. Folino's refusal to sign the declaration. Mr. Imai attested to the mailing of the 25 September 2001 letter to Mr. Folino's home address and Mr. Folino's lack of response to the letter or return of the executed Declaration/Power of Attorney.

Further evidence is provided by Ms. Percy's declaration which states that Mr. Folino did not respond to the 25 September 2001 letter or execute and return the Declaration/Power of Attorney. Ms. Percy states that she periodically contacted Mr. Folino via telephone requesting that he execute the Declaration/Power of Attorney, however, Ms. Percy does not detail these attempts.

On 27 August 2002 Ms. Percy again sent Mr. Folino a copy of the application and Declaration/Power of Attorney via e-mail. Ms. Percy states that she has "talked with Mr. Folino on several occasions. Mr. Folino initially stated that he had signed the Declaration/Power of Attorney and faxed a copy" to Magna. However, Ms. Percy states that there is no record of such transmission or receipt of the executed Declaration.

On the same day as her e-mail, 27 August 2002, Ms. Percy again spoke directly to Mr. Folino, "wherein he stated that he would not sign the Declaration/Power of Attorney until he had his lawyer review the Assignment." Ms. Percy concluded that Mr. Folino has refused to sign the Declaration/Power of Attorney. Petitioner filed his request for reconsideration on 28 August 2002.

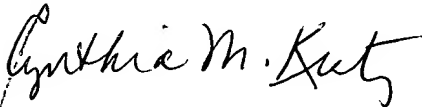
In light of Mr. Folino's response that "he would not sign the Declaration/Power of Attorney until he had his lawyer review the Assignment", and that sufficient time had not passed (from the telephone contact on 27 August 2002 to the filing of this petition on 28 August 2002) to allow Mr. Folino to consult with his lawyer, Petitioner has not allowed ample time for Mr. Folino to respond to the request for his signature or to imply his refusal to sign. Thus, Petitioner has not presented insufficient evidence to conclude that applicant/inventor Salvatore J. Folino has refused to sign the application. Petitioner's request for reconsideration is dismissed.

### **CONCLUSION**

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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